

REMARKS:

Claims 1-20 are pending, and claim 1 is amended herein.
Claims 9-13 are withdrawn from consideration.

The Non-Final Office action dated November 18, 2010 has been carefully considered and the following remarks are made in response.

Rejections of Claims 14-20 under 35 U.S.C. §102(b)

Claims 14-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Applicants Admitted Prior Art (AAPA).

The Office asserts that AAPA at paragraphs 51-52 and Figure 4 disclose all the elements of claims 14-20. Applicants respectfully disagree.

Claim 14 requires, among other features, "a free region formed in the body between the peripheral edge of said opening and the radially opposed one pocket, the free region being constructed so that the hydrostatic pad applies substantially no clamping pressure to the workpiece at the free region when in use."

The Office asserts that the claimed free region corresponds to free region 32' shown in Fig. 4 of the present application. However, reference number 32' of the Fig. 4 actually references a raised surface that is exactly the opposite of the claimed free region. This raised surface is mentioned in paragraph 57 of the application. As described, the pad 11' of Fig. 4 will apply clamping pressure to the workpiece at the raised surface.

This fact is also clear from comparing Fig. 4 to Fig. 8. The raised surface in Fig. 4 clearly extends outward generally from the pockets 21', 25', 27' and 23' to the opening edge 41'. In contrast, the free region 60a extends inward from the plateaus 34a and the edge 38a (see description at paragraph 54). Clamping force on the wafer W is **effectively zero** at free region 60a.

Because the raised surface 32' cannot be interpreted to be a free region as claimed, the rejection must be withdrawn. Claims 15-20 depend from claim 14 and are patentable for at least the same reasons as claim 14.

Rejections of Claims 1-8 under 35 U.S.C. §103(a)

Claims 1-4 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA alone. In view of the amendment of claim 1 and the arguments below, the rejection must be withdrawn.

The Office recognizes that the AAPA does not disclose "a total pocket surface area of all pockets in the body being less than said working surface area of the body such that a ratio of the pocket surface area to the working surface area is less than about 0.26" as claimed. Despite this fact, the Office asserts that it would have been obvious to one of ordinary skill in the art to modify the pocket size so the ratio would be less .26 ... "since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art." Citing *In re Boesch*, 617 F. 2d 272, 205 USPQ (CCPA 1980). And further "where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable

ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

However, the prior art fails to recognize that the ratio of pocket surface area to the working surface area is a result-effective variable. According to the MPEP and the case law, “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. MPEP 2144.05 citing, among others, *In re Boesch*. Because the prior art fails to recognize that the claimed variable is result-effective, the rejection is in error.

Additionally, claim 1 is amended to recite that the at least one pocket is arcuate in shape and elongate in a generally circumferential direction around the pad. This claimed combination of features is not shown or suggested by the prior art. In particular, this combination is not shown or suggested by the AAPA or by Weldon. Accordingly, the rejection must be withdrawn for this additional reason.

Claims 2-8 depend from claim 1 and are patentable for at least the same reasons as claim 1. Note that the rejection of dependent claims 5-7 over AAPA in view of Weldon need not be addressed because the claims depend from allowable claim 1.

Conclusion

The claims are believed to be in form for allowance. The undersigned requests a telephone call from the Examiner if this might expedite allowance.

Applicants believe that no fee is due. However, if this belief is in error the Commissioner is hereby authorized to charge any additional fees in connection with this Amendment C to Deposit Account Number 012384 in the name of ARMSTRONG TEASDALE LLP.

Respectfully submitted,

/Michael G. Munsell/

Michael G. Munsell
Reg. No. 43,820
ARMSTRONG TEASDALE LLP
7700 Forsyth Boulevard, Suite 1800
St. Louis, Missouri 63105
(314) 621-5070

MGM/csl
Via EFS